04-16-02

1164

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, D.C. 20231

In re PATENT APPLICATION

Inventors: **LEVITEN**
Appln. No.: **09/904,181**
Filed: **July 11, 2001**
Title: **Transgenic Mice Containing Ubiquitin-Specific Protease Gene Disruptions**

Group Art Unit: **1164**
Examiner: **Paras J. P.**
Docket/Order #. **R-456**
Deposit Acct **50-1271**
Customer # **26619**

4-22-02

Date: **April 12, 2002**

RESPONSE TO RESTRICTION REQUIREMENT TRANSMITTAL

Sir:

Please file the enclosed *Response* in the above-identified application. The signature below is to be treated as the signature to the enclosure in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

1. Small Entity previously claimed	Claims remaining	Highest # paid for		Present Extra	Small Entity	Add'l Fee	Fee Code
2. Total Claims	**12**	minus	**33** =	**0**	x $9. =	+**0**	203
3. Independent Claims	**6**	minus	**15** =	**0**	x 42. =	+**0**	202
4. If amendment enters multiple dependent claim(s) for the first..... add					+ $140. =	+	204
5. Original due date: April 12, 2002							
6. **Petition is hereby made** to extend the due date to cover the date this response is filed, for which the requisite fee is enclosed					1 mo $55 2mos $200 3mos $460 =		215 216 217
7. Enter any previous extension fee paid and				(subtract)	-		
8.				Total fee for extension of time:		+**0**	
9. If Terminal Disclaimer is enclosed, add Rule 20(d) official fee.....					+ $55. =	+	248
10. If IDS enclosed requires Official Fee, ... add or if Rule 97(d) Petition, ... add					+ $180. = + $130. =	+ +	126 122
11. After-Final Request Fee per Rules 129(a) and 17(r).....					+ $370. =	+	246
12. No. of additional inventions for examination per Rule 129(b):.....				ea	x $370. =	+	249
13. Petition fee for						+	
TOTAL FEE: ☒ **CHARGE AUTHORIZATION** ☐ **ENCLOSED** =						**$0**	

Charge Statement: The Commissioner is hereby authorized to charge any missing or insufficient fees relative to this application, or credit any overpayment, to our Account/Order Nos. above, for which purpose a duplicate copy of this sheet is enclosed.

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Express Mail Label: *EV 007607489 US*
Date of Deposit: *April 12, 2002*

I certify that this paper and listed enclosures are being deposited with the U.S. Post Office "Express Mail Post Office to Addressee" under 37 CFR 1.10 on the above date, addressed to Commissioner for Patents, BOX AMENDMENT, Washington, D.C. 20231

Joyce Vogel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Michael W. Leviten

Group Art Unit: 1632

Serial No.: 09/904,181

Examiner: Peter Paras Jr.

Filed: July 11, 2001

Atty. Dkt.: R-456

For: TRANSGENIC MICE CONTAINING UBIQUITIN-SPECIFIC PROTEASE GENE DISRUPTIONS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed March 12, 2002, concerning the Examiner's restriction to the claims, Applicant hereby provisionally elects, with traverse, Group II (claims 5-10, 12 and 17-20), drawn to a transgenic cell comprising a disruption in a ubiquitin-specific protease gene, a transgenic non-human animal comprising a disruption in a ubiquitin-specific protease gene, a method of producing a transgenic mouse comprising a disruption in a ubiquitin-specific protease gene, a transgenic mouse comprising a disruption in a ubiquitin-specific protease gene that exhibits increased PPI, a method of producing the same transgenic mouse and a cell derived from the same transgenic mouse, and methods of using the same transgenics for identifying an agent that modulates the function of a ubiquitin-specific protease.

In the restriction, the Examiner asserts that claims 1-25 are drawn to six distinct subjects, grouped as: Invention I (claims 1-4), drawn to a targeting construct that is homologous to the ubiquitin-specific protease gene and method of producing the same; Invention II (claims 5-10, 12 and 17-20), drawn to a transgenic cell comprising a disruption in a ubiquitin-specific protease gene, a transgenic non-human animal comprising a disruption in a ubiquitin-specific protease gene, a method of producing a transgenic mouse comprising a disruption in a ubiquitin-specific protease gene, a transgenic mouse comprising a disruption in a ubiquitin-specific protease gene

that exhibits increased PPI, a method of producing the same transgenic mouse and a cell derived from the same transgenic mouse, and methods of using the same transgenics for identifying an agent that modulates the function of a ubiquitin-specific protease; Invention III (claims 13-15 and 22-23), drawn to methods of identifying agents that modulate the expression or modulate the function of a ubiquitin-specific protease gene in a cell *in vitro*; Invention IV (claims 16 and 24), drawn to agents that modulate ubiquitin-specific protease expression or function and agents that ameliorate phenotypes associated with ubiquitin-specific protease gene disruptions; Invention V (claim 25), drawn to an agent that modulates a ubiquitin-specific protease gene; and Invention VI (claims 11 and 21), drawn to a method of identifying an agent that modulates the expression of a ubiquitin-specific protease in a transgenic non-human animal, particularly a mouse, having a disrupted ubiquitin-specific protease gene. Applicant respectfully requests reconsideration and withdrawal of the requirement.

The Examiner asserts that the claims of Inventions I, II, IV and V each from the other are unrelated because the different inventions have different modes of operation, different function, and different effects and are thus patentably distinct inventions. The Applicant disagrees with the Examiner's conclusion in that the claims of Invention I, II, IV and V are related to one another, and a separate search or examination that would seriously burden the Examiner would not be required.

The Examiner further asserts that the claims of Invention III and VI are patentably distinct because the inventions are drawn to patentably distinct inventions, each with a distinct purpose and further comprising distinct methodologies and using different products. The Applicant disagrees with the Examiner's assertion in that the claims of Invention III and the claims of Invention VI are related. Thus, a separate search or examination of these claims would not seriously burden the Examiner.

The Examiner also asserts that the claims of Inventions I, II, IV and V are patentably distinct from the methods of Inventions III and VI as the inventions have different modes of operation, different function and different effects from the other. The Applicant disagrees with the Examiner's conclusion in that the claims of Inventions I, II, IV and V and the claims of Inventions III and VI are related. A separate search or examination on these claims can be made without serious burden to the Examiner.

Although Applicant has provisionally elected Group II for purposes of advancing prosecution of the present application, Applicant contends, for the foregoing reasons, that the restriction requirement is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement.

Respectfully submitted,

Date: 12 APR 2002

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Enclosures